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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,144	12/02/2003	David K. Swanson	03-0117 (US01)	5308

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VISTA IP LAW GROUP LLP  
12930 Saratoga Avenue  
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EXAMINER
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ROANE, AARON F

ART UNIT	PAPER NUMBER
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3739

MAIL DATE	DELIVERY MODE
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08/27/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/727,144	<b>Applicant(s)</b> SWANSON ET AL.	
	<b>Examiner</b> AARON ROANE	<b>Art Unit</b> 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 38-59 is/are pending in the application.
- 4a) Of the above claim(s) 9,12,19,21,23,44 and 46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8,10,11,13-18,20,22,38-44 and 47-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/24/08,4/30/08,3/28/08</u> .                                 | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

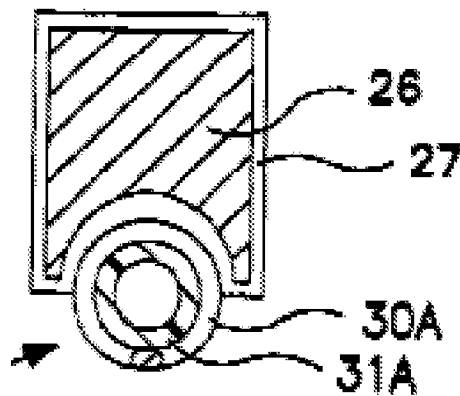
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 13-18, 22, 38-43, 45, 47-49 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Francischelli et al. (USPN 6,807,968) in view of Tetzlaff et al. (USPN 6,277,117) in further view of Hooven (USPN 6,889,694).

Regarding claims 1, 14-18, 38, 40, 41, 43 Francischelli et al. disclose an ablating/coagulating forceps apparatus comprising an insulative base member (27 or analogous counterparts in other embodiments) defining a groove therein and clearly shown in the figure below and adjacent to a support member (31A or analogous counterparts in other embodiments), the groove formed within the base member being configured to receive the support member; a coagulation element or means for transmitting coagulation energy, in the form of an electrode (30A or analogous counterparts in other embodiments) carried by the support member, see col. 2, line 47 through col. 4, line 59 and figures 1-5B. It should be

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further noted that Francischelli et al. disclose a source of coagulation energy, a clamp with first and second clamp members movable with respect to one another via a movement apparatus (pivot), see above cited passage. Francischelli et al. fail to disclose the mating structure is configured for removably securing the base member to the first clamp member. Francischelli et al. also fail to disclose a stimulation element or means for transmitting stimulation energy carried by the support member and a source of stimulation energy. Tetzlaff et al. also disclose an ablating/coagulating forceps apparatus (10) and teach providing an insulative base member (121) with a mating structure (collection of 122 and 124) that is removably securable to the clamp member in order to provide the device with a removable/replaceable electrode assembly, see col. 3-6 and figures 1-7. Hooven also discloses an ablating/coagulating forceps apparatus (70) and teach providing a stimulation element, in the form of an electrode (pacing electrode, 172) along with the source of stimulation energy (inherent) in order to verify ablating/coagulating quality, see col. 15-16 and figures 66 and 67. Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Francischelli et al., as taught by Tetzlaff et al., to provide an insulative base member with a mating structure that is removably securable to the clamp member in order to provide the device with a removable/replaceable electrode assembly, and as further taught by Hooven, to teach provide a stimulation element along with a source of stimulation energy, in the form of an electrode in order to verify ablating/coagulating quality.



Regarding claims 2, 3, 48 and 49 Francischelli et al. in view of Tetzlaff et al. in further view of Hooven disclose the claimed invention, see Tetzlaff et al. figures 1-7.

Regarding claims 4-8, 39, 42 Francischelli et al. in view of Tetzlaff et al. in further view of Hooven disclose the claimed invention.

Regarding claims 13, 22, 45 and 52, Francischelli et al. in view of Tetzlaff et al. in further view of Hooven disclose the claimed invention.

Regarding claims 53 and 54, Francischelli et al. in view of Tetzlaff et al. in further view of Hooven disclose the claimed invention except for explicitly reciting the base member is formed from a polymer in the form of polyurethane. It would have been obvious to one having ordinary skill in the art at the time the invention

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was made to a polymer for the base and/or a base made from polyurethane or any other insulative material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claim 57, Francischelli et al. further disclose the coagulation element (30A) is carried on the support member (31A), the support member being positioned within the coagulation element, see col. 3:54-col. 4:7 and figure 2A.

Regarding claim 58, Francischelli et al. in view of Tetzlaff et al. in further view of Hooven disclose the claimed invention.

Regarding claim 59, Francischelli et al. disclose the claimed invention, see figure 2A.

Claims 10, 20 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Francischelli et al. (USPN 6,807,968) in view of Tetzlaff et al. (USPN 6,277,117) in further view of Hooven (USPN 6,889,694) as applied to claims 1, 14 and 47 above, and further in view of being extremely well known in the art.

Regarding claims 10, 20 and 50, Francischelli et al. in view of Tetzlaff et al. in further view of Hooven disclose the claimed invention except for explicitly reciting first and second coagulation element wires connected to the coagulation element. It is extremely well known in the art to provide a coagulating element with first and second wires in order to transmit energy and cause coagulation. Therefore the examiner takes official notice of the first and second coagulation element wires connected to the coagulation element.

Claims 11 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Francischelli et al. (USPN 6,807,968) in view of Tetzlaff et al. (USPN 6,277,117) in further view of Hooven (USPN 6,889,694) as applied to claims 1 and 47 above, and further in view of being extremely well known in the art.

Regarding claims 11 and 51, Francischelli et al. in view of Tetzlaff et al. in further view of Hooven disclose the claimed invention except for explicitly reciting the stimulation element is located distally with respect coagulation element. Pending a statement of criticality the presently claimed location of the stimulation element is considered to be an obvious design choice over the location disclosed by Francischelli et al. in view of Tetzlaff et al. in further view of Hooven and is not patentably distinct thereover.

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Claim 55 is rejected under 35 U.S.C. 103(a) as being unpatentable over Francischelli et al. (USPN 6,807,968) in view of Tetzlaff et al. (USPN 6,277,117) in further view of Hooven (USPN 6,889,694) as applied to claims 1 and 47 above, and further in view of Eggers et al. (6,032,674)

Regarding claim 55, Francischelli et al. in view of Tetzlaff et al. in further view of Hooven disclose the claimed invention except for explicitly reciting an adhesive that holds the coagulation element and the support member in place. It is extremely well known in the art to secure electrodes to insulators or insulating members by using an adhesive to securely fix them together. As an example, Eggers et al. disclose electrosurgical system having an elongate probe (10) and teach "sealing material 402 is used to seal annular gaps between hollow tube 400 and electrode terminal 58 and to adhesively join electrode terminal 58 to hollow tube 400" in order to fix the electrode(s) to the insulative tube and provide structural integrity, see col. 15:29-col. 16:67 and figures 1-2E. Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Francischelli et al. in view of Tetzlaff et al. in further view of Hooven, as taught by Eggers et al., to adhesively bond the electrode to the tubular insulating member in the form of PTFE (insulative) tubular member in order to fixedly secure them together and provide structural integrity.



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Claim 56 is rejected under 35 U.S.C. 103(a) as being unpatentable over Francischelli et al. (USPN 6,807,968) in view of Tetzlaff et al. (USPN 6,277,117) in further view of Hooven (USPN 6,889,694) as applied to claims 1 and 47 above, and further in view of Fogarty et al. (6,558,408)

Regarding claim 56, Francischelli et al. in view of Tetzlaff et al. in further view of Hooven disclose the claimed invention except for explicitly reciting the mating structure is configured for slidably securing the base member to the first clamp member. Fogarty et al. disclose a forceps clamping device having an insulative base/padding (80) and teach providing the padding (80) with a mating structure (either a slot seen in figure 2A or head 86 and neck 96 seen in figure 4) in order to slidably securing the base/padding member to the clamp member (66), see col. 3:22-col. 5:13 and figures 1-15. Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Francischelli et al. in view of Tetzlaff et al. in further view of Hooven, as taught by Fogarty et al., to provide the base member with a mating structure that securably engages the clamp member in order to slidably securing the base/padding member to the clamp member as an alternate/equivalent releasable securing means between the base member and clamping member.

***Response to Arguments***

Applicant's arguments filed 5/19/2008 have been fully considered but they are not persuasive. The examiner will address each argument/remark in turn, however, it should be noted that Applicant's main argument/remark concerns the base member disclosed by the Francischelli et al. patent.

Beginning on page 10, first paragraph and continuing to page 11, line 10, Applicants argument is that Francischelli et al. do not disclose 1) a base member, And therefore 2) a mating structure on the base member for removably securing the base member to the first clamp member and 3) a groove defined within the base member. Applicant does not consider the "thin coating" of paint (albeit an insulating member) to be a base member and that the coating of paint "would not even be considered by a person of ordinary skill in the art who understands that paint 27 is not, does not have, and is not related to, a base member including a mating structure and defining and groove and being configured for removably securing the base member to a clamp member," see page 11, lines 1-5. Point taken, however the examiner respectfully yet strongly disagrees. Although operational characteristics of an apparatus may be apparent from the specification, we will not read such characteristics into the claims when they cannot be fairly connected to the structure recited in the claims. See *In re Self*, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982). See *In re Prater*, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969) and *In re Winkhaus*, 527 F.2d 637, 188 USPQ 129 (CCPA 1975). The base member as claimed is defined by 1) a groove that engages a

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support member that supports an electrode, 2) a mating structure for engaging a clamp member and 3) is insulative. The layer/coating of paint disclosed by Francischelli et al. and interpreted by the examiner as a base member, clearly discloses a groove for engaging a "support member" that carries an electrode as seen in figure 2A (and also in figures 2B-2D) and that the paint is "insulative" and covers a metallic core of the jaw, see col. 3:64-col. 4:7 and figures 1A-2D. Applicant's comments regarding a needed scratch in the coating of paint are at this point irrelevant, as the base member of Francischelli et al. clearly discloses the claimed groove within the base member. Additionally and similarly to Tetzlaff et al., Francischelli et al. disclose an electrosurgical forceps device and Tetzlaff et al. is used to teach providing a base member that is removably secured to the clamp member by a mating structure. Although the present interpretation may be broad, there is nothing in the claim language to preclude such an interpretation.

Next, regarding Applicant's argument/remark on the support member (previously defined as 24, but now defined as 31A due to newly recited subject matter (see claim 57), the argument/remark is moot due to a new ground of rejection that, again, has been necessitated by an amendment.

Regarding Applicant's arguments/remarks addressing the other prior art references, Applicant's arguments simply rely on a statement that the other references do not address the supposed deficiencies of the Francischelli et al. patent.

The examiner would like to summarize Applicant's argument as being a two prong argument. Firstly, Applicant asserts the supposed base member of Francischelli

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et al. does not disclose a groove. Again this is clearly incorrect as the groove defined by and with the base member of Francischelli et al. is shown in the figures 2A-2D.

Secondly, Applicant asserts the supposed base member of Francischelli et al. is clearly not a base member as "paint 27 is, quite simply, paint," see page 12, line 7. This argument clearly overlooks 1) the similarities in form and function between what is positively recited **in the claims** and what the prior art discloses 2) what is not positively recited, such that, there is no positive recitation that distinguishes the presently claimed invention from what the prior art **as a whole discloses and teaches**. The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art, and all teachings in the prior art must be considered to the extent that they are in analogous arts.

Additionally, Applicant's arguments/remarks attack the rejections by attacking the references individually. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In regards to the new claims, new prior art has been cited for some rejections. Additionally, the examiner notes claim 57 only required a new interpretation of the support.

The presently searched and examined claims have been rejected and **this office action is made FINAL.**

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON ROANE whose telephone number is (571)272-4771. The examiner can normally be reached on Monday-Friday 5:30AM-3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/AARON ROANE/  
Examiner, Art Unit 3739

/Roy D. Gibson/  
Primary Examiner, Art Unit 3739